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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,751	08/30/2001	Dan Stoianovici	56436(71699)	8459
21874 7590 02/25/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/943,751

**Applicant(s)**

STOIANOVICI ET AL.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26, 28-36, 38, 39, 41-46, 48-54 and 56-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28, 41-45, 51, 56 and 57 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-25, 29-34, 38, 39, 46, 48-54 and 58-61 is/are rejected.
- 7) ☒ Claim(s) 15, 35, 36, 62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The request filed on 1/2/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/943,751 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14,16-25,29-34,38,39,46,48-54, 58-61 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Madhani et al (6,786,896) in view of Taylor et al (5,695,500).

Madhani et al disclose in figures 1-3 and 20, a device for percutaneous surgery in a soft tissue target, including: a first arm (304 or 1m1), a first drive mechanism (310) is coupled to the first arm and configured to translate the first arm from an initial position to any of a number of other positions from the initial position, thereby also translating the penetrating member or needle towards the target area, where the first arm and the first drive mechanism are coupled to the manipulation device. Furthermore, the first arm is configured and arranged to rotatably support the penetrating member about the translational axis of the penetrating member, and where a second drive mechanism (302), where a second arm (1m1') spaced apart from the first arm arranged to support a portion of the needle and where the second arm aligned with the first

arm so the first arm and distal portion of the needle are movable toward the second arm. But Madhani is silent regarding a needle arranged to rotate about translational axis of the needle.

Taylor teaches a needle arranged to rotate about translational axis of the needle (see fig. 9, element 241).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Madhani by constructing a needle taught by Taylor in order to provide the apparatus with a tissue penetrating system with a relatively greater precision and smaller incisions by the needle, and where the first drive mechanism (310) includes a linear guide (inherent feature), where a second drive mechanism (302) is coupled to the penetrating member (312) and is configured to cause the penetrating member to rotate, and where the second drive mechanism comprises a gear member (see col. 12, lines 23-27) secured to the penetrating member and coupled to a motor (MO-M7), and where a second arm (5 or 1m1') is coupled to the first drive mechanism (310), where the second drive mechanism is coupled to the penetrating member (312) so as to cause the penetrating member to rotate about the translational axis of the penetrating member.

***Allowable Subject Matter***

3. Claims 26,28,41-45,51,56-57 are allowed over the art of record.

Claims 15,35,36 and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen  
Examiner  
Art Unit 3734

VN, 2/15/2008

/Julian W. Woo/Primary Examiner, Art Unit 3773